

Application Serial Number 10/023,118  
Response to Office Action  
Dated August 14, 2006

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**REMARKS / DISCUSSION OF ISSUES**

Claims 1-15 are presented for further examination and consideration.  
Claims 1 is in independent form.

**Rejections under 35 U.S.C. § 102**

Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Novis, et al.* (U.S. Patent 7,088,112). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 is drawn to a processing device and features:

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"...second communication means *disposed within the housing for the contactless retrieval of control information stored in a data carrier which is detachably connected to the housing of the processing device...*"

Thus, pursuant to claim 1, the second communication means is disposed within the housing and a data carrier is detachably connected to the housing.

At page 2, the Office Action of January 24, 2006 asserts:

Examiner respectfully disagrees with Applicant's assertions of Novis. Novis discloses a housing 11, which includes a slot 16 for receiving a smart card 18. Novis also discloses that the smart card may be inserted or not inserted into the slot 16 of the housing 11 (see col. 3, lines 35-41, and col. 6, lines 16-20). The insertion and the removal of the smart card into and from the slot, however broadly, represent the smart card being detachably connected to the housing. Therefore, the rejection stands.

Moreover, at page 3, the Office Action asserts that the second communication means pursuant to claim 1 is disclosed in Fig. 3, column 3, lines 38-41; column 4, lines 22-27; and column 11, lines 29-30.

Applicants have reviewed the portions of *Novis, et al.* relied upon in the Office Action and respectfully submit that the reference fails to disclose at least one feature of claim 1. To wit, the reference to *Novis, et al.* explicitly discloses a smart card 18 disposed in a slot 16 of the housing 11. The smart card 18 is removable from the housing and the portable electronic devices 10 and 28 may be programmed for use as a cellular telephone when the smart card 18 is not engaged. (Kindly refer to column 6, lines 16-21 of the applied art.) Thus, the reference discloses that the device 10 can be adapted to function as a cell phone without the smart card 18; but does not disclose that the smart card can be either within the housing or connected to the housing as specifically recited in claim 1. By way of

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a simple analogy, if the device 10 were an automobile and the smart card 18 were a radio system disposed in a compartment of the car, by the teachings of *Novis, et al.*, the automobile would function without the radio within the automobile. This is a reasonable teaching. However, it would be unreasonable to conclude that this serves as a teaching of the radio's being connected to the body of the automobile.

At column 4, lines 41-45 (not relied upon by the Office Action), the reference to *Novis, et al.* discloses that while slot 16 is preferable for correctly positioning smart card 18, other structures may be utilized, including simply placing the smart card 18 adjacent to a sensor structure that is externally accessible. While this does provide an alternative to the slot 16, this is in no way a teaching of a second communication means disposed within the housing and a data carrier is detachably connected to the housing. Rather, this vague disclosure only provides for the sensor is to be externally accessible and for the smart card 18 to be adjacent thereto.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1. Therefore, a *prima facie* case of anticipation has not been made, and this claim is patentable over the applied art. Moreover, because all pending claims (including claim 4) depend from claim 1, either directly or indirectly, these claims are patentable at least because claim 1 is patentable over the applied art.

#### Rejections under 35 U.S.C. § 103

Claims 2, 3 and 5-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Novis, et al.* in view of secondary references. While Applicants in no way concede the propriety of these rejections and maintain their right to address these rejections, as necessary, in further and future replies, because these

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claims depend from claim 1 directly or indirectly, claims 2, 3 and 5-15 are patentable over the applied art.

**Conclusion**

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

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